

R E M A R K S

Claims 53-85 are currently pending in the application. Claims 1-52 are previously canceled.

Substance of Interview

Applicants appreciate the Examiner's courtesy in allowing Applicants' Representatives to conduct a Personal Interview at the USPTO on July 25, 2006. During this Interview, Applicants submitted arguments traversing the rejection of claims 67 and 83 under 35 USC §112, first paragraph, and claims depending therefrom.

In the present Office Action, the Examiner rejected the claims for recitation of the genus "said partial or complete PIV genome or antigenome including a mutation encoding a substitution of amino acid 456 of the L protein by another amino acid", stating that the Applicants were not in possession of the claimed genus at the time of filing.

In response, Applicants stated that a skilled artisan is able to envision the 20 amino acids that may be located at position 456 of the L protein, therefore Applicants were in possession of the claimed genus. Moreover, Applicants stated that even if the rejection is more properly stated as an enablement rejection because it is not immediately clear what substitutions are operable, the rejection is still improper because a skilled artisan is amply guided by the specification to routinely determine which embodiments are operable.

The Examiner alleged that the specification does not disclose a nexus between the *type* of amino acid substituted (*e.g.* hydrophilic amino acids) and attenuation. In response, Applicants submitted that the specification does disclose a nexus between the location of the amino acid substitution and attenuation. (See, *e.g.* page 57, line 8, through to page 58, line 8 in the specification as filed). The Examiner stated she would reconsider this rejection. In a follow-up

teleconference on August 7, 2006, the Examiner agreed to withdraw the §112, first paragraph rejection.

Claim Rejection-35 USC § 112, first paragraph

Claims 67, 68 and 83-85 stand rejected under 35 USC §112, first paragraph, as failing to comply with the written description requirement. As stated *supra*, the Examiner agreed on August 7, 2006, in a teleconference with Applicants' representatives to withdraw the rejection. Accordingly, this rejection is overcome.

Rejection under non-statutory double-patenting

09/083,793

Claims 53-85 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 144-215 of copending Application No. 09/083,793.

Applicants submit herewith a Terminal Disclaimer, thereby obviating this ground of rejection.

09/586, 479

Claims 53-85 are provisionally rejected on the on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 84-163 of copending Application No. 09/586, 479.

Applicants submit herewith a Terminal Disclaimer, thereby obviating this ground of rejection.

09/459, 062

Claims 53-85 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-30 and 46-74 of copending Application No. 09/459, 062.

Applicants submit herewith a Terminal Disclaimer, thereby obviating this ground of rejection.

09/733, 692

Claims 53-85 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 180-222 of copending Application No. 09/733,692.

Applicants submit herewith a Terminal Disclaimer, thereby obviating this ground of rejection.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Mark J. Nuell (Reg. No. .) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. Error! Unknown document property name. for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: Aug. 18, 2006

Respectfully submitted,

By: Mark J. Nuell
Mark J. Nuell, Ph.D., Reg.No. 36,623
Birch, Stewart, Kolasch & Birch, LLP
8110 Gatehouse Road
Suite 100 East
POB 747
Falls Church, Virginia 22040-0747
703/205-8000
Attorney for Applicant

Attachment: Terminal Disclaimer